

REMARKS/ARGUMENTS

Claims 1-15 are pending in the above-identified application. Claim 10 has been amended to clarify that the claimed system includes a tangible medium coupled to the processor and having stored instructions that, if executed by the processor, will cause the processor to perform the recited operations. The recited operations include determining the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, wherein the distribution is determined in response to a signal related to a size of the patient's pupil. The amendment is supported in the specification as originally filed including, for example, at paragraph 0061 and Figure 4. As such, no new matter has been added. Applicants respectfully request reexamination and reconsideration of all pending claims.

Rejections under 35 U.S.C. § 112

Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

As an initial matter, applicants respectfully note that originally filed claims are considered part of the specification, so that the subject application did include an adequate written description of originally filed claims 1-9. See, e.g., MPEP § 2163(I)(A). Moreover, claims 1-9 are supported throughout the specification (and hence throughout the specifications of the parent applications), and not only at the one paragraph of the specification cited in the Office Action. For example, adjusting an ablation cut profile of the multifocal ablation shape in response to the size of the pupil is described, e.g., at paragraphs 0025-0027, 0070-0071, and Figure 8. Use of clinical data for guidance in determining an ablation shape for mitigation of presbyopia is disclosed, for example, at paragraph 0069. Therefore, as the support provided throughout the specification as filed, including the originally filed claims (e.g., current claims 1-9), was sufficient to satisfy both the written description and enablement requirements of 35 U.S.C. § 112, first paragraph, withdrawal of the rejection is respectfully requested.

Claims 11-15 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, it is stated that claims 11-15 fail to further limit claim 10 from which they depend. Such rejections are respectfully traversed.

As amended, claim 10 defines a system comprising a tangible medium coupled to the processor and having stored instructions that, if executed by the processor, will cause the processor to perform certain recited operations. Claims 11-15 more fully define the operations, and thereby recite additional structural limitations for the stored instructions of the tangible media. As such, a skilled artisan would clearly be apprised of the structural metes and bounds of the invention defined by claims 11-15 and, accordingly, withdrawal of the rejection is respectfully requested.

Claims rejected under 35 U.S.C § 103

Claims 10-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Frey in combination with Largent. Such rejections are respectfully traversed.

As amended, claim 10 recites a combination of a laser for making a beam of an ablative light energy; a processor in electrical communication with the laser; and a tangible medium coupled to the processor and having stored instructions that, if executed by the processor, will cause the processor to perform the recited operations. Such operations include controlling a distribution of a series of laser beam pulses to ablate the multifocal shape on the eye. Per claim 10, the multifocal ablation shape produces a first region of the cornea providing a near vision correction and a second region of the cornea providing a far vision correction. The processor, per the claimed instructions of its tangible media, determines the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, where the distribution is determined in response to a signal related to *a size of the pupil* so as to balance the near vision correction and the far vision correction of the multifocal treatment for the patient. Applicants submit that those elements, which are incorporated into each of dependent claims 11-15, are missing from the cited references, either alone or in combination, thereby precluding a finding of *prima facie* obviousness.

Frey teaches a system and method where the cornea is reshaped in an area approximately equal to the dark adapted pupil size of the eye in order to reduce halo effect and/or improve night vision. Rather than disclosing determining the distribution of laser beam pulses to ablate multiple regions of the multifocal ablation shape, particularly wherein the distribution is determined in response to a signal related to a size of the patient's pupil (as required by the current claims) the teachings of Frey are limited to adjusting one aspect of the ablation region in response to pupil size - i.e., the overall extent of the region of the cornea subject to ablation. Thus, Frey does not teach determining multiple ablation regions of a multifocal ablation shape in response to a signal related to a size of the patient's pupil and, therefore, does not provide the advantages of treating a cornea of an eye of a patient to mitigate presbyopia with a multifocal ablation shape according to the system defined by current claim 10.

Largent teaches a method of vision correction via shaping multiple regions of a cornea to provide vision correction at multiple corresponding distances. However, Largent does not teach determining the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape in response to a signal related to pupil size and, therefore, fails to provide the teachings that are missing from Frey (see above). In fact, Largent's disregard of pupil size variations among different patients in determining the size for each of its multiple regions may have been consistent with the thinking in the field at the time, but is directly contrary to the inventive structure of claim 10. Furthermore, even if, for arguments sake only, one were to attempt to combine the references by employing the pupil scaling taught by Frey with the multi-region corneal laser ablation taught by Largent, the combination would appear to be limited to adjusting only the overall size of the ablation region such that the outer periphery of the ablation region covers the maximum pupil size, as Frey's approach changes only the overall size of the treatment *without any* change in shape. Thus, only one aspect of the ablation region (i.e., overall diameter of the ablated region) would be adjusted based on pupil size in the hypothetical combination of cited references. The combination would still not teach determining the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, wherein the distribution is determined in response to a signal related to a size of the patient's pupil, as recited by claim 10.

Therefore, as set forth above, one of ordinary skill would not have found the invention of claim 10 obvious in view of the cited references because neither Frey nor Largent, alone or in combination, teach each and every element of the claimed invention. In particular, no reasonable combination of the cited references teach or suggest determining the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, wherein the distribution is determined in response to a signal related to a size of the patient's pupil. Accordingly, withdrawal of the rejection of claims 10-15 under 35 U.S.C. § 103(a) is respectfully requested.

Double Patenting Rejections

Claims 10-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,280,435.

The rejection of the claims is acknowledged. Applicants submit that, upon resolution of allowable claims, a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) will be timely filed if necessary.

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,63,619.

The rejection of the claims is acknowledged. Applicants submit that, upon resolution of allowable claims, a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) will be timely filed if necessary.

MARC ODRICH *et al.*
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PATENT

CONCLUSION

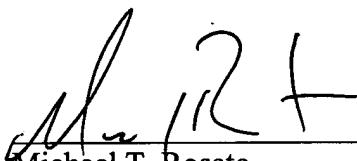
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Date: _____

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